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CENTRAL FAX CENTER**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**JAN 14 2009**

Application No.: 10/603,913      Confirmation No.: 4355  
Applicant(s): Hashizume et al.  
Filed: 06/24/2003  
Art Unit: 3726  
Examiner: Chang, Rick K.  
Title: A Process for Manufacturing a Cover  
  
Attorney Docket No.: 852.0029.U1 (US)  
Customer No.: 29,683

Commissioner For Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Petition to Commission  
(37 C.F.R. §1.181)

Sir:

This is a petition under 37 C.F.R. §1.181 to invoke the supervisory authority of the Commissioner.

Statement of Facts

1. In an Office Action mailed 07/17/2008, the examiner issued restriction citing 35 U.S.C. §121. Two groups of claims were specified as follows:

Species I: Claims 1-20 and 34

Species II: Claims 33 and 35

2. In a Response filed on 08/12/2008, applicants elected Species I (Claims 1-20 and 34), but with traverse.

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3. In an Office Action mailed on 11/14/2008, the examiner continued the restriction and made the restriction FINAL.

Point to be Reviewed

Is the restriction of the claims 1-20 and 33-35 into two different groups of claims proper?

Action Requested

The Commissioner for Patents is requested to reverse the restriction requirement regarding the restriction of the claims in Species I and II and direct the examiner to examine claims 1-20 and 33-35.

**Discussion**

MPEP §806.03 states that:

"Where the claims of an application define the same essential characteristics of a single disclosed embodiment of an invention, restriction therebetween should never be required. This is because the claims are \*not directed to distinct inventions; rather they are different definitions of the same disclosed subject matter, varying in breadth or scope of definition."  
(emphasis added)

Restriction should not be required where the claims define the same essential characteristics of a single disclosed embodiment.

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Independent claims 1, and 33 vary in scope, but they both relate to the single embodiment shown in Figs. 4 and 5. Thus, independent claims 1, and 33 are but different definitions of the same disclosed subject matter, merely varying in breadth or scope of definition.

The examiner stated that the two species are drawn to two different and mutually exclusive features (as mentioned in further detail below, the examiner provides different restriction requirements including different mutually exclusive features in the restriction office action of 07/17/2008 and the office action of 11/14/2008). The examiner cited MPEP §808.01(a) as his rationale for restriction. However, "species" always refer to **different** embodiments of the invention (see MPEP §806.04(e)). Additionally, the examiner has identified the species by identifying claims. However, MPEP § 806.04(e) also states that claims are definitions (or descriptions) of inventions and that *claims themselves are never species*.

Applicants submit that the claims are not directed to two species. For example, claims 1 and 33 claim features of the embodiment shown in Figs, 4 and 5. **Only one embodiment** is shown in the Figs. 4 and 5.

In this case, the specification describes the moulded cover 22 as incorporating the electrical circuitry element 10 and includes connector structures 118 which correspond to the regions 18 in the moulding space 16 (see page 2, lines 29-31). Additionally, the specification describes that the connecting structures 118 are formed during the injection moulding step

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(see page 4, lines 32-34). Further, the specification states that the component 36 comprises a first connecting member 36A for insertion into one of the connecting structure 118 and the second component 38 comprises a second connecting member 38A for insertion into the other of the connecting structures 118 (see page 5, lines 27-31).

Additionally, as can be seen in Figs. 4 and 5, the cover 22 comprises the integral electrical connector structure 118 which is configured to removably receive at least a portion of a mating connecting member 36A (the integral electrical connector structure comprises an opening which forms an electrical connector receiving area for the connecting member 36A) of the electronic component 36 therein.

Similarly, the integral electrical connector structure 118 is provided on the cover member 22 (and is integrally formed with the cover member) and configured to removably receive at least a portion of the mating member 36A.

Thus, independent claims 1 and 33 are directed to the single embodiment shown in Figs. 4 and 5.

Even if, for the sake of argument, there were two species, the species are not distinct as argued by the examiner. MPEP §803 states that one of the criteria for a proper requirement for restriction between patentably distinct inventions is that there would be a serious burden on the examiner if restriction is not required.

In this case there is no serious search burden. Independent claims 1, and 33 are both directed to a cover member having an

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integral electrical connector structure configured to receive a portion of a connecting member therein. Merely because the claims recite various features which are connected in design and used together in the single disclosed embodiment does not justify a serious search burden on the examiner for searching claims 1, and 33 in the same application.

In addition, 37 CFR § 1.143 states that:

"In requesting reconsideration the applicant must indicate a provisional election of one invention for prosecution, which invention shall be the one elected in the event the requirement becomes final. The requirement for restriction will be reconsidered on such a request. If the requirement is repeated and made final, the examiner will at the same time act on the claims to the invention elected."

In the restriction requirement (dated 07/17/2008) the examiner presented the following:

Species 1: claims 1-20 and 34, drawn to the integral electrical connector structure is configured to removably receive at least a portion of a mating connecting member of the electronic component therein.

Species 2: claims 33 and 35, drawn to the opening forms an electrical connector receiving area, and wherein the electrical connector receiving area is configured to receive at least a portion of a connecting member of the electronic component therein.

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In accordance with MPEP §821.01 and 37 CFR §1.143, if the examiner was of the opinion that the restriction requirement was proper, the requirement should have been **repeated** and made final.

Instead, the examiner included a new and different restriction requirement. In section 1 of the Office Action (dated 11/14/2008), the examiner states that the "[d]ue to their different structures, the integral electrical connector structure is **provided on the cover member** and configured to removably receive at least a portion of a mating member in Species 1; while in Species 2, the integral electrical connector structure is **integrally formed with the cover member** and incapable of removably receive at least a portion of a mating member.

Applicants submit that the restriction requirement has not been properly repeated and made final. Thus, applicants are unsure which features the examiner is arguing as mutually exclusive (for the basis of patentably distinct Species I and II). Is it the opening which forms an electrical connector receiving area (argued in the Restriction Office Action of 07/17/2008)? Or is it the integral connector structure provided on (or integrally formed with) the cover member (argued in the Office Action of 11/14/2008?). Applicants submit that these appear to be two different restriction requirements, and thus clarification is requested as the traversal to the restriction requirement (filed on 8/12/2008) provided arguments in response to the restriction requirement in the restriction office action of 07/17/2008). Applicants also request further clarification of "the integral electrical

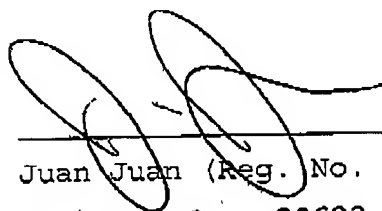
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connector structure is integrally formed with the cover member and incapable of removably receive at least a portion of a mating member", as it appears that the examiner has mischaracterized applicants' invention.

**Summary**

A requirement for two separate patents does not appear to be appropriate in view of the subject matter of the claims in Species I, and II. Therefore, the Commissioner for Patents is requested to reverse the examiner's restriction regarding the claims of Species I, and II, and direct the examiner to examine all the claims in these groups (i.e. claims 1-20 and 33-35).

Respectfully submitted,

  
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Juan Juan (Reg. No. 60,564)

1/14/2009  
Date

Customer No.: 29683  
Harrington & Smith, PC  
4 Research Drive  
Shelton, CT 06484-6212  
203-925-9400

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